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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/381,742	10/13/1999	NEWTON B. WHITE, JR.	GRENP001NP	4358
21121	7590	11/18/2003	EXAMINER	
OPPEDAHL AND LARSON LLP			ALVAREZ, RAQUEL	
P O BOX 5068			ART UNIT	PAPER NUMBER
DILLON, CO 80435-5068			3622	

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/381,742	WHITE, JR., NEWTON B.
	Examiner Raquel Alvarez	Art Unit 3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 15 October 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 65-123, 129, 137-140, 163-166 and 168-208 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) 65-123, 129, 137-140, 163-166, 168, 182, 183, 185-190, 196 and 204-208 is/are allowed.

6) Claim(s) 169- 181, 184, 191-195, 200-202 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

 1. Certified copies of the priority documents have been received.

 2. Certified copies of the priority documents have been received in Application No. _____.

 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

 a) The translation of the foreign language provisional application has been received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____

4) Interview Summary (PTO-413) Paper No(s) _____

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

DETAILED ACTION

1. This office action is in response to communication filed on 10/15/2003.
2. Claims 65-123, 129, 137-140, 163-166, 168 and 169-208 are presented for examination.

Claim Rejections - 35 U.S.C. § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 196 is directed to non-statutory subject matter. Claim 196 recites a data stream. However, the data does not impact functionality to the data stream as claimed. As such, the claimed invention recites non-functional descriptive material, i.e. mere data. The allowance of such a claim would exalt form over substance. For the above mentioned reason, claim 196 is deemed non-statutory.

Claims 169-171, 173-177, 179, 182-183, 184-208 15 are non-statutory. Applicant has not given any process or any structural means for carrying out the invention. Applicant's invention is not implemented with any specific automated computer apparatus. Consequently, the claims are analyzed based upon the underlying process and thus rejected as being directed to a non-statutory process. the claims are not in the "technological" or "useful" arts, and the claims do not affect or define the technology. See *In re Toma*, 197 USPQ 852 (CCPA 1978).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 177 and 178 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims call for a digital signature but then it recites that it is secured without requiring the digital signature. It is confusing as to if the digital signature is claimed or not. For purpose of examination, it will be examined as if the digital signature is required.

1. Claims 169, 173, 179, 182, 184, 185, 187, 191, 197, 203, 204, as amended is confusing because the claims recite "includes without limitation a computer apparatus". The claims do not positively recite if a computer is included or exclude.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 169-176, 179, 181 and 184 are rejected under 35 U.S.C. 102(b) as being anticipated by Adams et al. (3,573,747 hereinafter Adams).

With respect to claims 169-176, 179 and Adams teaches a method for operating an offer matching or information system for a traded item (abstract). Associating a first offer to buy or to sell the traded item with a first identifier (col. 10, lines 1-15 and col. 12, lines 1-9); receiving request for information where the request includes the first identifier (col. 10, lines 1-15 and col. 12, lines 1-9); the request is received in a manner that does not imply that that the request is from a person entitled to receive nonpublic information concerning the first offer (col. 12, lines 1-9); and in response to the request, sending a reply comprising a data item that concerns the first offer (col. 10, lines 1-36 and col. 12, lines 1-12).

Claims 170-171 further recites well known execution information and process of an offer.

Claim 174 further recites that the disclosee possesses information which discloses that a first related person satisfies a first condition and that first related person is acting as an agent for the first offer. Adams teaches that the disclosee (investor) is the one entering the information in the system and since it is obvious and well known for systems to have agents acting on behalf of the investors then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the disclosee having information about the agent because such a modification would allow the investor or disclosee to recognize the agent based on certain conditions and therefore he or she would know that the agent is acting on his or her trade.

With respect to claims 179 and 181, Adams further teaches publishing the information (col. 12, lines 51-62).

With respect to claim 184, the claim further recite and Adams further teaches the offer matching system monitoring the trade (col. 2, lines 73-, col. 3, lines 1-10).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 180, 191-195, 197-198, 200-202 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams.

With respect to claim 180, further recites well known execution information and process of an offer.

With respect to claims 191, 192, 194, 195, 197-199, 201-202, Adams teaches receiving from a first participant a first description of the first offer (i.e. subscriber A describes the first offer)(col. 10, lines 1-36); associating the first offer with a first identifier, the first identifier not associated with any offer other than the first offer (col. 10, lines 1-15 and col. 12, lines 1-9); receiving from a second participant a description of a second offer (i.e. subscriber B sends an offer to sell)(col. 10, lines 1-15); the offer matching system's executing the first offer at least in part against the second offer in accordance with a set of rules that govern the operation of the offer matching system (col. 10, lines 1-53); publishing a first data packet that comprises the first identifier and a first data item, the first data item concerning the first offer (col. 12, lines 51-62).

With respect to if the description did not disclose the first identifier, sending the first identifier to the first participant in a manner that discloses to the first participant that the first identifier is associated with the first offer. The participants have to identify the offers by reference numbers (col. 12, lines 4-13) therefore it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included sending the first identifier to the participant if the participant didn't disclose the identifier associated with the first offer because such a modification would allow for correct identification of the offers.

With respect to claim 193, since the first data item is responsive to the information requested by the disclosee on changes and modifications and changes to the offer and since the second offer is to be matched with the first offer to find out if a offer can be executed then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included selecting a predetermined relationship between the first data item and the second offer to obtain the above mentioned advantages.

Claim 200 further recites that the first data item specifies a price at which the first offer was executed against the second offer. Official notice is taken that is old and well known to publish the execution certain items, for example when a home is sold the price and the location is published and it becomes public information. It would have been obvious to a person of ordinary skill In the art at the time of Applicant's invention to have included specifying a price at which the first offer was executed against the second offer because such a modification

would provide the public with an idea of the sales prices of the items.

With respect to claim 203, in addition to the rejections addressed, Adams teaches storing in the offer matching system a first association among a first participant and a first monitor (col. 2, lines 73-, col. 3, lines 1-10).

7. Claims 177-178, are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams in view of Hauser et al. (WO 97/25801 hereinafter Hauser).

With respect to claims 177-178 in addition to the limitations previously addressed above in the rejections to claims 169, 172-173 and 175-176, the claims further recite that the reply comprises a digital signature. On the other hand, Hauser teaches secure anonymous information exchange in a network, and the data sets are digitally signed, as far as necessary to provide proof of the partner. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included a digital signature in the reply as taught in Hauser because such a modification would provide the above mentioned advantage.

Allowable Subject Matter

8. The following claims are allowable.

With respect to claims 76-81 and 163-166, the Examiner asserts that the

first data item concerns the first offer, and before receiving the first data item, the first disclosee does not posses information which discloses that the first data item concerns the first offer, whereby the first discloser, which already possesses information which discloses that the first related person satisfies the first condition, gains possession of information which discloses that the first data item concerns the first offer, is not taught In the prior art of record.

With respect to claims 65-75, 82-87, 101-117, 163-165 and 168, the Examiner asserts that at a time when the first offer was capable of execution, the third offer executed In whole or In part against a fourth offer, wherein the fourth offer is not the first offer, and that at a first time when the first offer was capable of execution: the third offer executed In whole or In part against a fifth offer, wherein the fifth offer is not the first offer, and the first offer could have executed In whole or In part against the fifth offer In accordance with the set of rules if the offer matching system had not possessed information concerning any other offers for a same side as the first offer; and In response to the first request, and without the offer matching system's determining that the first request is from a person entitled to receive confidential information concerning the third offer, In combination with the other limitations is not taught In the prior art of record.

With respect to claims 94-100, the Examiner asserts that the second data packet is published In a manner that permits the first disclosee to receive it regardless of whether the first disclosee has a right to receive confidential information concerning the first offer, and prior to publication of the second data

packet, the first disclosee does not possess information which discloses that the second data item concerns the first offer; the first disclosee's receiving the second data packet and detecting that the second data packet includes the first identifier, whereby the first disclosee, which already possesses information which discloses that the first related person satisfies the first condition, gains possession of information which discloses that the first data item concerns the first offer, In combination with the other limitations is not taught In the prior art of record.

With respect to claims 88-93, 118-123, the Examiner asserts that the first data item concerns the first offer, and the monitor does not already possess information which discloses that the first data item concerns an offer that satisfies the first condition, whereby the first monitor gains information which discloses that the first data item concerns an offer that satisfies the first condition; and attempting to avoid publicly disclosing that the first data item concerns an offer that satisfies the first condition, is not taught In the prior art of record.

With respect to claims 129 and 137 , the Examiner asserts that calculation of the second data item depends upon a third data item that is not obtained from the offer matching system, In combination with the other limitations is not taught In the prior art of record.

With respect to claim 138-140, the Examiner asserts that after receiving the

first description but before the offer matching system determines that the future time has occurred, executing the second offer at least in part against the third offer, wherein, if the offer matching system had already determined that the future time had occurred, the second offer would have had a lower execution priority than the first offer and the offer matching system would not have executed the second offer even in part against the third offer, is not taught in the prior art of record.

With respect to claims 182-183, the Examiner asserts that the first disclosee's detecting that the data packet includes the first identifier, whereby the first disclosee gains possession of information which discloses that the data item concerns the first offer.

With respect to claims 185-186 and 204-208, the Examiner asserts that the system determining a minimum price that is the lowest price at which the sell offer may be executed against the buy offer is not taught in the prior art of record.

With respect to claims 187-190, 196, the examiner asserts that the offer matching system executing the first offer at least in part against the second offer in accordance with a set of rules that govern the operation of the offer matching system is not taught in the prior art of record.

Response to Arguments

9. Applicant's arguments filed 10/15/2003 have been fully considered but they are not persuasive.

10. In response to Applicant's arguments with respect to 196 on the grounds that a data stream is non-statutory subject matter. The data stream does not impart functionality to the computer, i.e., it is not a computer component. Non-functional descriptive material per se is not statutory i.e. abstract idea. A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See *In re Warmerdam*, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). See also *Schrader*, 22 F.3d at 295, 30 USPQ2d at 1459. The claim also lacks a tie to technology.

11. With respect to the 101 rejection pertaining to claims 169-171, 173-177, 179, 182-183 and 184-208, the rejection is sustained. The preamble was amended to include "includes without limitation a computer apparatus" first of all, without is a negative limitation in the claims because it doesn't specifically recite what is included but rather what is excluded. The invention in the body of the claims must recite technology. If the invention in the body of the claim is not tied to technological art, environment, or machine, the claim is non statutory. See MPEP 2106 IV 2(b).

12. With respect to the 112 rejection pertaining to claim 177 and 178, the rejection is sustained. The Applicant is claiming a digital signature to secure the data and in the same claim is claiming other techniques for securing the data such as other encryption techniques. Both techniques of securing the same data, claimed in the same claim causes confusion and therefore the rejection is maintained.

13. The Applicant argues that Adams does not teach sending or receiving a request that includes an identifier associated with an offer. The examiner respectfully disagrees with Applicant because in Adams (col. 10, lines 4-), the identifier "20,562" was given to

Subscriber A in order to identify his or her offer, Subscriber B using the identifier to request information on the identified offer. Therefore Adams satisfies the claimed limitation of receiving a request that includes an identifier associated with the offer.

14. Applicant argues that Adams does not teach sending or receiving a request in a manner that does not imply that the request is from a person entitled to receive nonpublic information concerning the offer. The Examiner respectfully disagrees with Applicant because in Adams *summary of invention* clearly teaches "**it is an object of the invention to provide an apparatus and method of automatically, anonymously and equitable buying and selling fungible properties between subscribers**" (col. 1, lines 44-47) and col. 3, line 9 recites "**absolute anonymity is maintained**".

15. With respect to claim 171, Adams teaches the well known feature of not responding to a request until after an event occurs (col. 5, lines 69-, col. 6, line 1).

16. With respect to Applicant's arguments that Adams does not disclose publishing the information. The Examiner respectfully disagrees with Applicant because Adams teaches on col. 12, lines 51-62, performing the financial dealings associated with the matched offer, including printing and preparing appropriate summary therefrom. Adams printing the information regarding the matched offer satisfies Webster's Collegiate Dictionary's definition of producing or releasing for distribution : PRINT.

17. Applicant argues that Adams does not teach receiving a message from the first monitor that approves the first offer and storing it. The claim doesn't necessarily recite that the first offer is a matched offer and therefore the Examiner is interpreting the first offer placed by the offeror. Adams teaches Manual operation

means 628 will send a withdrawal notice to the subscriber who booked the Book entry offer which has just been compared, and which has just been found to be below the minimum accepted by the system. The sequence is then routed via branch 630 to manual operation means 632. Manual operation means 632 will send the same message as manual operation means 628 to the console 220. The sequence is then routed via branch 634 to manual operation means 636. Manual operation means 636 will then send the withdrawal to the withdrawal journal. Sequence is then routed via branch 638 to reference D640.

The sequence is routed from reference point D640 via branch 642 to process means 644. The process means 644 has access to the Book and will delete the book entry offer which has been found to be below the minimum quantity accepted by the system. If the offer is accepted by the system then it is stored in order to allow the subscribers to bid on it.

18. With respect to Applicant's arguments pertaining to a predetermined relationship between the first data item and a second offer. The Examiner never said that Adams discloses this predetermined relationship but rather than given in Adams that the first data item is responsive to the information requested by the disclosee on changes and modifications and changes to the offer and since the second offer is to be matched with the first offer to find out if a offer can be executed then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included selecting a predetermined relationship between the first data item and the second offer to obtain the above mentioned advantages.

Point of contact

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9326.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

Raquel Alvarez
Examiner
Art Unit 3622

R.A.
11/14/03



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